D. REMARKS

Applicants respectfully request reconsideration of the outstanding rejections and reexamination of the present application in light of the following amendments and remarks.

Status of the Claims

Claims 1, 3, 4, 6-8, 10-15, 17, and 18 are currently pending and currently amended. Claims 2, 5, 9, 16, and 19-27 are currently canceled.

Claims Amended to Overcome 35 USC 112 rejections

The Office Action rejects claims 3, 4, 10, 11, and 17 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. [Office Action, p. 2]

As to claim 3, the Office Action states "claim 3 recites the limitation "said selection of site addresses" in line 17. There is insufficient antecedent basis for this limitation in the claim." [Office Action, p. 2] Applicants amend claim 3 to particularly point out and distinctly claim the subject matter which Applicants regard as the invention through the insertion of accessible prior to site addresses, where "said selection of accessible site addresses" is previously referred to within claim 3.

As to claim 4, the Office Action states "claim 4 recites the limitation "said particular client system" in line 7. There is insufficient antecedent basis for this limitation in the claim." [Office Action, p. 2] Applicants amend claim 4 to particularly point out and distinctly claim the subject matter which Applicants regard as the invention through the deletion of "particular" prior to "client system", where "said client system" is previously referred to within claim 4.

As to claim 10, the Office Action states "claim 10 recites the limitation "said selection of site addresses" in line 18. There is insufficient antecedent basis for this limitation in the claim." [Office Action, p. 2] Applicants amend claim 10 to particularly point out and distinctly claim the subject matter which Applicants regard as the invention through the insertion of accessible prior to site addresses, where “said selection of accessible site addresses” is previously referred to within claim 10.

As to claim 11, the Office Action states “claim 11 recites the limitation “said particular client system” in line 7. There is insufficient antecedent basis for this limitation in the claim.” [Office Action, p. 2] Applicants amend claim 11 to particularly point out and distinctly claim the subject matter which Applicants regard as the invention through the deletion of “particular” prior to “client system”, where “said client system” is previously referred to within claim 11.

As to claim 17, the Office Action states “claim 17 recites the limitation “said selection of site addresses” in line 20. There is insufficient antecedent basis for this limitation in the claim.” [Office Action, p. 2] Applicants amend claim 17 to particularly point out and distinctly claim the subject matter which Applicants regard as the invention through the insertion of accessible prior to site addresses, where “said selection of accessible site addresses” is previously referred to within claim 17.

Claims Amended to Clearly Overcome 35 USC 101 rejections

The Office Action rejects claims 15-18 and 25-27 under 35 USC 101 as being directed to non-statutory subject matter. [Office Action, p. 3] In particular, the rejection states: “the claims refer to “a recording medium”. The specification refers to machine-readable medium, which includes transmission media. The recording medium must be in an embodiment which includes physical articles or objects to establish a statutory category of invention such as a manufacture and which are structurally and functionally interconnected with the software in such a manner to, in and of itself, enable any usefulness to be realized.” [Office Action, p. 3]

Regardless of whether the rejection of claims 15-18 and 25-27 is correct, Applicants amend claims 15-18 and 25-27 to clarify that the claim is directed to statutory subject matter. In particular, Applicants amend the preambles of claims 15 and 25 to clarify that each claimed program is tangibly embodied on a computer-readable medium. The preamble of claims 15 and 25 teach the computer program product residing on a volatile or non-volatile computer readable medium comprising instructions which when executed on a computer system cause the computer system to. Paragraph 0032 of the specification of the present application clarifies that the processes of the present invention which are described in the context of a fully functioning data processing system are capable of being distributed in the form of a computer readable medium having instructions stored thereon which when executed on the computer system cause the computer system to perform the processes. The specification teaches that a computer readable medium may include a non-volatile media, such as a floppy disk, a flexible disk, a hard disk, magnetic tape or any other magnetic medium, a compact disk ROM (CD-ROM) or any other optical medium, punch cards or any other physical medium with patterns of holes, a programmable ROM (PROM), an erasable PROM (EPROM), electrically EPROM (EEPROM), a flash memory, and other memory chip or cartridge, or any other medium from which the computer system can read instructions. In addition, the specification teaches that a computer readable medium may include a volatile media including dynamic memory such as RAM. Separately, the specification distinguishes that a computer readable medium may include a transmission media.

Applicants amend the preambles of claims 15 and 25 to teach the computer program product embodied in a volatile or non-volatile readable medium, which is clearly a tangible physical medium distinguished from transmission media. In addition, Applicants amend claims 15 and 25 to teach the recording medium which comprises instructions which when executed on a computer system cause the computer system to perform the processes of the invention, where such a recording medium is a statutory category of invention which is structurally and functionally interconnected with the software in such a manner to, in and of itself, enable usefulness to be realized as required under 35 USC 101.

In view of the amendments to claims 15 and 25 and also to dependent claims 17, 18, 26 and 27 to maintain antecedent basis and clearly show that the claims are directed to statutory subject matter, Applicants respectfully request withdrawal of the rejection of these claims under 35 USC 101 and issuance of a timely notice of allowance.

The Pending Claims are Allowable over Beyda

Claims 1, 3, 4, 6-8, 10-15, 17, and 18 are not anticipated by Beyda

The Office Action rejects claims 1, 3-8, 10-15, 17, and 18 under 35 U.S.C. 102(e) as being anticipated by Beyda et al. (US Patent 6,636,965) (herein referred to as Beyda). [Office Action, p. 3] Claim 2, 5, 9, and 16 are canceled. Applicants respectfully traverse the rejections of pending claims 1, 3, 4, 6-8, 10-15, 17, and 18 under 35 USC 102(e) and under 35 USC 103(a) in view of amendments to the claims.

Claim 1

Claim 1 currently reads as follows:

1. A method for selectively displaying mirrored site addresses in an electronic mail communication, comprising:

responsive to receiving an electronic mail communication addressed to a particular recipient from among at least one intended recipient at an electronic mail client from which said particular recipient accesses said electronic mail communication at a client system communicatively connected to at least one network with a plurality of mirrored site addresses each providing separate access to a same selection of information ~~for a particular recipient from among at least one intended recipient~~, transmitting by said electronic mail client a separate signal to each of said plurality of mirrored site addresses to detect whether each of said plurality of mirrored site addresses is accessible to said client system via said at least one network;

detecting a selection of accessible site addresses for said particular recipient from among said plurality of mirrored site addresses from which a separate return signal is received at said client system responsive to said separate signal transmitted to each of said plurality of mirrored site addresses; and

displaying only said selection of accessible site addresses in a display of said electronic mail communication to said particular recipient.

As noted in the summary of the interview above, claim 1 is amended to include additional elements based on the specification of the present invention, such that no new matter is added through the amendments to the claims.

In particular, with regard to the element of responsive to receiving an electronic mail communication addressed to a particular recipient from among at least one intended receipt at an electronic mail client from which said particular recipient accesses said electronic mail communication at a client system communicatively connected to at least one network with a plurality of mirrored site addresses each providing separate access to a same selection of information, the specification of the present invention teaches this element in Figure 3, Figures 6A and 6B, and Figure 9 and paragraphs 0006, 0009, 0042, 0047, 0048, and 0049.

In addition, as to the element of transmitting by said electronic mail client a separate signal to each of said plurality of mirrored site addresses to detect whether each of said plurality of mirrored site addresses is accessible to said client system via said at least one network, the specification of the present invention teaches this element in Figure 3 and Figure 9 and paragraphs 0049, 0061, and 0065.

Further, as to the element of detecting a selection of accessible site addresses for said particular recipient from among said plurality of mirrored site addresses from which a separate return signal is received at said client system responsive to said separate signal transmitted to each of said plurality of mirrored site addresses, the specification of the present invention teaches this element in Figure 3 and Figure 9 and paragraphs 0049, 0061, and 0065.

As previously asserted, in view of the amendments to claim 1, claim 1 is allowable over the prior art cited by the Examiner. In particular, Applicants note that claim 1 is amended to incorporate elements of dependent claim 2, which is rejected under 35 USC 103(a) as unpatentable under Beyda in view of Tech Target. Regardless of whether the rejection of claims 1 or 2 is correct, Applicants respectfully traverse the rejection of the claims under Beyda and also under Beyda in view of Tech Target.

Beyda does not anticipate claim 1

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Beyda does not teach each and every element of claim 1 or enable each and every element of this claim, claim 1 is not anticipated, the rejection should be withdrawn, and the claim should be allowed.

First, Applicants respectfully assert that Beyda does not anticipate claim 1 under 35 USC 103(e) because Beyda does not teach or enable the elements of detecting a selection of accessible site addresses for said particular recipient from among said plurality of mirrored site addresses and displaying only said selection of accessible site addresses in a display of said electronic mail communication to said particular recipient. Claim 1 teaches the electronic mail client determining which mirrored site addresses are accessible to the client system and displaying on a selection of the accessible site addresses in a display of the electronic communication to the particular recipient. In particular, claim 1 is amended to teach that responsive to receiving an electronic mail communication addressed to a particular recipient from among at least one intended receipt at an electronic mail client from which said particular recipient accesses said electronic mail communication at a client system communicatively connected to at least one network with a plurality of mirrored site addresses each providing separate access to a same selection of information the electronic mail client determines the selection of site addresses which are accessible site addresses. Beyda describes a message processor, which is an email server, which receives messages from one station, addressed to a recipient, and routes the messages to another station to the recipient. *Beyda*, col. 2, lines 43-53. In Beyda, a sender may create a single message containing a common message for general distribution and comments that can only be received by selected individuals based on whether the sender specifies for the individuals to receive a comment. *Beyda*, col. 3, lines 2-30. To enable this type of message, in Beyda, the message processor either (1) prior to delivery to the recipient station, filters the single message for a particular recipient and forwards only the portions readable by the particular recipient to a particular recipient station; or (2) delivers the same message to all recipients, with some portions encrypted, with an icon or other prompt to the user indicating there is a comment attached to the message and only allows those users entering a proper password or security code to access the comment. *Beyda*, col. 3, lines 32-59 and col. 4, lines 9-20. Thus, Beyda describes a message processor pre-filtering content or controlling access to delivered content based on a password. No portion of Beyda, however, describes the receiving stations described in Beyda as receiving an electronic communication and selectively displaying only a portion of the received content in a display of the electronic mail communication. Thus, no portion of Beyda teaches or enables the elements of claim 1 of an electronic mail client determining the selection of accessible site addresses at the client system and displaying only said selection of accessible site addresses in a display of said electronic mail communication to said particular recipient.

Second, Applicants respectfully assert that Beyda does not anticipate claim 1 under 35 USC 102(e) because Beyda does not teach or enable the received electronic mail communication with a plurality of site addresses each providing separate access to a same selection of information. Beyda describes that a user may compose a single message with comments that can only be received by selected individuals based on whether the sender specifies for the individual recipients to receive a comment. *Beyda*, col. 3, lines 2-30. Beyda's comments do not teach the content of the received electronic mail communication is multiple site addresses each providing separate access to a same set of information. Thus, no portion of Beyda teaches or enables the elements of claim 1 of an electronic mail client receiving an electronic mail communication with a plurality of site addresses each providing separate access to a same selection of information.

Claim 1 as amended to incorporate claim 2 is not obvious under Beyda in view of Tech Target

Applicants respectfully assert that claim 1 is not obvious under Beyda in view of Tech Target. As previously noted, claim 1 is amended to incorporate elements of claim 2 which the Office Action rejects under 35 USC 103(a) under Beyda in view of Tech Target. [Office Action, p. 10] In particular, the Office Action states that Beyda

> "fails to teach transmitting a signal to each of said plurality of mirrored site addresses; and receiving a return signal from each site address comprising said selection of accessible site addresses. Tech Target teaches pinging which transmits a packet to an address and then receives a response from the address (page 1). Beyda et al and Tech Target are analogous art because they are both related to data transmission over a network. At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the ping command in Tech Target with the system in Beyda et al because a target address is able to be verified to exist and is able to accept requests (Tech Target, paragraph 1)." [Office Action, p. 11]

Under the Graham Test, claim 1 is not obvious under Beyda in view of Tech Target

Applicants respectfully assert that because the differences between claim 1 when compared with Beyda and Tech Target are not such that claim 1 as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art of communication systems, claim 1 is not obvious under Beyda in view of Tech Target. As noted in the Office Action under 35 USC 103(a) a patent may not be obtained though the invention is not identically disclosed as described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. In *Graham v. John Deere*, the Supreme Court clarified that "under 103, in considering the obviousness or nonobviousness of the subject matter, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved, in addition to evaluating evidence of secondary considerations." *Graham*, 383 U.S. 1, 148 USPQ 459 (1966).

As to the scope and contents of Beyda, Applicants note that Beyda describes that a user may compose a single message with comments that can only be received by selected individuals based on whether the sender specifies for the individual recipients to receive a comment. *Beyda*, col. 3, lines 2-30. Beyda describes that the message controller distributing the electronic message either filters the message sent to each terminal for access by a recipient to only include the contents allowed for that recipient or sends the message to a terminal with portions encrypted and requiring a proper password entry to access. *Beyda*, col. 3, lines 32-59 and col. 4, lines 9-20. Tech Target describes a Ping program that "lets you verify that a particular IP address exists and can accept requests… Ping is used diagnostically to ensure that a host computer you are trying to reach is actually operating." *Tech Target*, paragraph 1.

As to the differences between claim 1 and the prior art of Beyda and Tech Target, first, claim 1 teaches an electronic mail communication received at an electronic mail client at a client system communicatively connected to at least one network with multiple mirrored site addresses each providing separate access to a same selection of information and displaying only an accessible selection of the multiple mirrored site addresses in a display of the electronic mail communication. The teaching of claim 1 is different from Beyda and Tech Target because neither Beyda nor Tech Target, separately or in combination, teaches an electronic mail client receiving a communication with multiple mirrored site addresses each providing separate access to a same selection of information and displaying only a selection of accessible site addresses. Based on this difference between claim 1 and the prior art, claim 1, when viewed as a whole, would not be obvious to one with skill in the art of electronic communication systems because Beyda only describes pre-filtering content sent to an electronic mail client or sending encrypted content to an email client. In contrast, claim 1 teaches sending the electronic communication with all the mirrored site addresses to an electronic mail client but only displaying a selection of accessible addresses.

In addition, as to the differences between claim 1 and the prior art of Beyda and Tech Target, claim 1 further teaches an electronic mail client detecting whether each of the mirrored site addresses is actually accessible to the client system at which a recipient accesses the electronic mail communication through an electronic mail client by transmitting signals to each of the mirrored site addresses. In particular, claim 1 teaches a client system at which an email including site addresses is received where the client system determines which site addresses listed in the email return a signal indicating accessibility and displays only the selection of accessible site addresses in the display of the electronic mail communication. Throughout the specification, it is clear that the mirrored site addresses accessible to a client system may vary based on the networks to which a client system communicatively connects and the locations of the mirrored site addresses. The teaching of claim 1 is different form Beyda and Tech Target because neither Beyda nor Tech Target, separately or in combination, teaches an electronic mail client filtering site addresses displayed within an electronic mail based on whether the electronic mail client can actually access the network location of the site addresses. Further, when the scope and contents of Beyda are examined that describe a messaging controller for controlling the portions of an email that a recipient views based on the portions of the email the sender authorizes the recipient to view, it is clear that Beyda describes content control through pre-filtering or encryption, not network location accessibility determination. There is no IP address in Beyda that needs to be pinged or a reason to adapt Beyda's teaching to determine accessibility of the network location, as pinging is described in Tech Target. Based on this difference between claim 1 and the prior art, claim 1, when viewed as a whole, would not be obvious to one with skill in the art of electronic communication systems because Beyda only describes a messaging controller determining whether a sender of an email has authorized a recipient to view a portion of the email. In contrast, claim 1 teaches a method for an electronic mail client at which an electronic communication is received for determining which site addresses in the electronic communication return a signal indicating accessibility of a network location and displaying the accessible selection of site addresses in the display of the electronic communication.

In view of the foregoing, it is clear that claim 1 is not obvious under Beyda and Tech Target under the requirements of 35 USC 103(a) as applied in a Graham inquiry, and the claims should be allowed.

A prima facie case of obviousness is not established as to claim 1 when amended to incorporate claim 2

As to the Examiner's burden of proving a prima facie case of obviousness, Applicants respectfully assert that a prima facie case of obviousness is not established under Beyda and Tech Target in view of claim 1 and therefore the claim should be allowed. To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Applicants respectfully submit that there is no suggestion or motivation explicitly of implicitly in Beyda or in the knowledge generally available to one of ordinary skill in the art to modify Beyda by Tech Target to teach each and every elements of claim 1 and therefore the Examiner has impermissibly used "hindsight" occasioned by Applicants own teaching to reject the claims.

The Office Action asserts that "At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the ping command in Tech Target with the system in Beyda et al because a target address is able to be verified to exist and is able to accept requests (Tech Target, paragraph 1)." [Office Action, p. 11] Applicants disagree with this statement of suggestion or motivation and respectfully assert that there is no suggestion or motivation in Beyda, Tech Target, or the knowledge of one with skill in the art to modify Beyda by Tech Target and that such a suggestion is merely an impermissible use of hindsight occasioned by Applicants' own teachings.

Claim 1 teaches a method for an electronic mail client at which an electronic communication is received for determining which site addresses in the electronic communication return a signal indicating accessibility of a network location and displaying the accessible selection of site addresses in the display of the electronic communication. As previously noted, Beyda describes a sender composing an email with comments specified for particular recipients and a message controller distributing the electronic message that either filters the message sent to each terminal for access by a recipient to only include the contents allowed for that recipient or sends the message to a terminal with portions encrypted. *Beyda*, col. 3, lines 32-59 and col. 4, lines 9-20. In addition, as previously noted, Tech Target describes a Ping program that "lets you verify that a particular IP address exists and can accept requests… Ping is used diagnostically to ensure that a host computer you are trying to reach is actually operating." *Tech Target*, paragraph 1.

While the Office Action states that it would have been obvious to a person of ordinary skill in the art to use the ping command in Tech Target with the system in Beyda et al because a target address is able to be verified, no portion of Beyda describes a target address for which verification is required to determine accessibility. Even where Beyda describes the message processor prompting a user to enter a password and only allowing a user to view encrypted content if a password is properly entered, there is not an address for the content that needs to be verified nor does Beyda describe identifying an address within an electronic communication and verifying accessibility to that address. Thus, because Beyda does not describe a network address that needs to be verified or identifying a network address in a communication to verify, neither Beyda nor the knowledge generally available to one with skill in the art suggests or motivates modification to teach identifying and verify the accessibility of a particular network location from an electronic communication. Because there is no suggestion or motivation for modifying Beyda to teach responsive to receiving an electronic mail communication addressed to a particular recipient from among at least one intended receipt at an electronic mail client from which said particular recipient accesses said electronic mail communication at a client system communicatively connected to at least one network with a plurality of mirrored site addresses each providing separate access to a same selection of information, transmitting by said electronic mail client a separate signal to each of said plurality of mirrored site addresses to detect whether each of said plurality of mirrored site addresses is accessible to said client system via said at least one network, or detecting a selection of accessible site addresses for said particular recipient from among said plurality of mirrored site addresses from which a separate return signal is received at said client system responsive to said separate signal transmitted to each of said plurality of mirrored site addresses, a prima facie case of obviousness is not established. Because prima facie obviousness is not established, Applicants respectfully request withdrawal of the rejection and allowance of claim 1.

Claim 8 and 15

Claim 8 and 15 are rejected on similar grounds as claim 1 [see Office Action, pp. 6, 8] and are amended to incorporate dependent claims 9 and 16, which are similar to dependent claim 2 and are rejected on similar grounds as claim 2 [see Office Action, pp. 11, 12]. Therefore, claims 8 and 15 are allowable for at least the same reasons that claim 1 is allowable.

Claims 3, 4, 6, 7, 10-14, 17, and 18

As to claims 3, 4, 6, 7, 10-14, 17, and 18, Applicants respectfully assert that because claims 3, 4, 6, 7, 10-14, 17, and 18 are dependent upon allowable claims 1, 8, and 15, then claims 3, 4, 6, 7, 10-14, 17, and 18 are also allowable by virtue of the dependency. In particular, Applicants respectfully assert that because claims 3, 4, 6, 7, 10-14, 17, and 18 are dependent upon claims 1, 8 and 15 for which the Examiner has not proved a prima facie case of obviousness, a prima facie case of obviousness is also not established with reference to claims 3, 4, 6, 7, 10-14, 17, and 18.

In addition, as to claims 4, 11, and 18, Applicants respectfully assert that Beyda does not anticipate these claims because Beyda does not teach or enable detecting whether said client system receiving said electronic mail communication is compatible with a resource located at each of said selection of accessible site addresses. Claim 4, which is representative of claims 11 and 18 with regard to subject matter and rejection teaches the elements of detecting whether said client system receiving said electronic mail communication is compatible with a resource located at each of said selection of accessible site addresses and indicating in said display of said electronic mail communication whether said client system is compatible with said resource located at each of said selection of accessible site addresses. The Office Action cites Beyda, col. 4, lines 21-51 as describing "Beyda et al shows the system see if the user is compatible by checking to see if the user is able to access the additional data and as reading on the detecting element." [Office

Action, p. 5] Applicants respectfully note that the Office Action cites this same portion of Beyda as also reading on the limitation in claim 3 of detecting whether said particular recipient is privileged to access each site address from among said selection of accessible site addresses. [Office Action, p. 5] This portion of Beyda in col. 4 lines 21-51, cited by the Examiner as reading on both a determination of a recipient privilege to access a site address and a determination of a client system compatibility with a resource located at a site address, actually only describes a determination of whether a user enters required password or security code to access encrypted content within an electronic communication. Beyda's description of determining whether a user enters a required password to access encrypted content within an electronic communication does not teach determining whether a client system is compatible with a resource located at a site address accessible via a network. Therefore, because Beyda does not teach each and every element of claims 4, 11, and 18, Beyda does not anticipate these claims and the claims should be allowed.

Conclusion

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

No extension of time is believed to be necessary. If, however, an extension of time is required, the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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